

REMARKS/ARGUMENTS

The above-identified patent application has been reviewed in light of the Examiner's final Office Action dated April 14, 2008. No claims have been amended or canceled by this paper. Accordingly, Claims 1-7, 9-23 and 25-35 are now pending. As set forth herein, reconsideration and withdrawal of the rejections of the claims are respectfully requested.

The Pending Rejections

Claims 31-35 stand rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,995,101 to Clark et al. ("Clark"). Claims 1-15, 17-23 and 25-30 stand rejected under 35 U.S.C. § 103 as being obvious over Clark in view of U.S. Patent Application Publication No. 2004/0205514 A1 to Sommerer et al. ("Sommerer"), and claim 16 stands rejected under 35 U.S.C. § 103 as being obvious over Clark in view of Sommerer and further in view of U.S. Patent No. 6,243,724 to Mander et al ("Mander"). Reconsideration and withdrawal of the rejections of the claims as anticipated by or obvious in view of the cited references are respectfully requested.

In the final Office Action, the Examiner states that the combination of the Clark and Sommerer references teaches providing a preview of the actual consequence of selecting an item, in which the consequence of actually selecting that item includes an operation that is performed on a file that is open in a computer program presenting that item. Moreover, the Examiner argues that the Applicant's responses to the obviousness rejections presented in the previous Amendment and Response fail because they point out the deficiencies of those references individually. However, even taken in combination, the cited references do not teach, suggest or describe each and every element of the claims. Indeed, it is unclear how the absence of an element of the claims from the Examiner's rejections can be articulated other than by a discussion of the references individually, since it is not apparent how the proposed combination of those references would somehow result in a teaching of that element. Moreover, Applicant notes that a proposed combination of references must teach or suggest all of the claim limitations. Because the proposed combination of references does not teach or suggest all of the claim limitations, the rejections of the claims should be reconsidered and withdrawn.

The Office Action admits that the Clark reference does not provide a preview of an actual consequence of selecting an item. Instead, Clark is cited for displaying a demonstration of an

icon's function in the form of a tool tip. The Sommerer reference is cited for disclosing a hyperlink preview utility. From these disclosures, the Examiner concludes that it would be obvious to modify Clark to display an operation that is performed on a file that is open in a program presenting the first selectable item. However, the Office Action fails to provide support for such a conclusion, except to suggest that the combination of Clark and Sommerer benefits from some undescribed synergistic effect or magical amalgam to arrive at the claimed invention. Accordingly, the rejections of the claims appear to be an example of using the Applicant's disclosure as a template for the obviousness rejection, rather than a demonstration that the claimed invention would be obvious to one of ordinary skill in the art. In particular, given the absence of any disclosure in the cited references of providing a preview of an actual consequence of selecting an item, including displaying a preview of an operation that is performed on a file that is open in a computer program presenting the first selectable item, it is unclear from the Office Action how the references in combination suggest such a result. Instead, the Office Action simply states that one of skill in the art would infer that from the references.

The Office Action does discuss how the Clark reference provides tool tips that can be applied to control areas in a graphical user interface. However, Clark's tool tips and Sommerer's preview of a target resource page are not a suggestion to preview an actual consequence of selecting a first selectable item where the actual consequence is performed on a file that is open in a computer program presenting the first selectable item. Instead, Clark provides fixed descriptions or demonstrations of an icon's function, without operating on an application that is open in the program presenting the icon, while Sommerer discusses displaying a preview of a target resource page associated with a linking control, without operating on an application that is open in the program presenting the icon. Considered in combination, the disclosure of these references does not result in a suggestion to provide a preview of an actual consequence of selecting a selectable item that includes an operation performed on a file that is open in the application as generally claimed.

### The Claimed Invention

The invention as claimed displays a preview of an actual consequence of actually selecting a selectable item to a user. For example, as recited by amended independent Claim 1, the selectable item is not a representation of a file, and the actual consequences of actually selecting the selectable item that is displayed include an operation that is performed on a file that

is open in a computer program presenting the first selectable item. Claim 1 further specifies that the depiction of the actual consequence of actually selecting the selectable item is displayed in the absence of an actual selection of the selectable item. As set forth in independent Claim 17, a cursor hovering over a first selectable item causes a preview of an actual consequence of actually selecting a first selectable item to be displayed. In addition, the actual selection of the first selectable item performs an operation on a file that is open within an application that provides said first selectable item. Independent Claim 31 recites an apparatus for displaying a consequence of a selection to a user that includes “means for generating a depiction of an actual consequence of actually selecting said selectable item . . . wherein said selectable item is associated with an application program, wherein said actual consequence of selecting such selectable item performs an operation, and wherein said operation does not include opening a file.” Independent Claim 34 recites displaying a depiction of the actual consequences of actually selecting at least a first selectable item, wherein the actual consequences of selecting the first selectable item do not include opening a file. Accordingly, by way of illustration and not necessarily importing limitations into the claims, embodiments of the claimed invention provide the user with a preview of the effect or consequence of performing an operation on a file by selecting a selectable item. As such elements are not taught, suggested or described by the cited references, the rejections of the claims as unpatentable in view of those references should be reconsidered and withdrawn.

### The Clark Reference

The Clark reference is generally directed to a multi-level tool tip. In particular, when a user points to an area of interest in a graphical display on a computer monitor using a cursor, a first level of information is displayed. A subsequent level of information is then displayed if the user continues to point to that area of interest or if a selected key stroke is entered (Clark, abstract). In general, the tips provide textual explanations of an icon’s function, or a demonstration of the function. (Clark, column 2, lines 30-63.) Accordingly, Clark is limited to presenting information describing a selected item or presenting an example of the effect of selecting an item. Clark does not teach, suggest or describe providing a preview of the actual consequence of selecting an item. The failure of Clark to provide a preview of a consequence of selecting a selectable item is acknowledged by the Office Action. (See final Office Action dated April 14, 2008, page 3 and page 14.)

### The Sommerer Reference

The Sommerer reference is generally directed to a hyperlink preview utility and method. In particular, Sommerer discusses displaying a preview of a target resource page associated with a linking control, such as a hyperlink or visit node. (Sommerer, paragraph 8.) According to Sommerer, the preview is displayed adjacent to the linking control and may display layout and content information to a user. (*Id.*) However, Sommerer does not teach, suggest or describe previewing an actual consequence of an operation performed on a file that is open in a computer program presenting an item that can be selected to perform the operation. Instead, Sommerer provides a preview of a resource page. Previewing a resource page is different than previewing the actual consequence of an operation on a file that is open in a computer program presenting a selectable item where the operation can be performed by actually selecting the selectable item. Therefore, Sommerer does not suggest the limitations of the claims missing from Clark. Moreover, the combination of a tool tip as discussed by Clark and a preview of a target resource page does not provide a teaching or suggestion of previewing the actual consequence of an operation that is performed on a file that is open in a computer program.

### The Krause Reference

The final Office Action cites U.S. Patent No. 6,160,554 to Krause for teaching the use of a projection line when a preview window is invoked. However, the Krause reference does not discuss providing a preview of an actual consequence of making a selection as claimed, and therefore even if Krause is combined with the Clark and Sommerer references, it does not teach, suggest or describe all the elements of the pending claims.

### Conclusion

The final Office Action argues that the Sommerer reference teaches a hyperlink preview utility that is invoked by hovering over a hyperlink. From this, the Office Action concludes that Sommerer discloses providing a preview of a consequence of selecting a selectable item. The Office Action further concludes that it would be obvious to display a preview of an actual consequence of selecting a toolbar menu item as disclosed by Clark in view of the suggestion of Sommerer. According to the Office Action, one of skill in the art, having common knowledge

and common sense, would then reasonably be expected to provide a preview of an actual consequence of selecting a first selectable item as claimed.

However, and as highlighted by the argument set forth in the final Office Action, none of the cited references in fact disclose displaying a preview of an actual consequence of a selection on a file that is open in an application as claimed. Instead, the Office Action addresses such elements by simply arguing that it would be obvious. However, this argument is believed to be insufficient to support a rejections of the claims, because there is no suggestion to provide a preview of the actual consequence on a file that is open in a computer program resulting from a selection of an item presented by that computer program on the file, even if the references are considered in combination. Accordingly, the rejections of the claims as obvious should be reconsidered and withdrawn, and the claims should be allowed.

In view of the foregoing it is submitted that the rejections of the claims as anticipated by or obvious in view of the cited references should be reconsidered and withdrawn. The application therefore appearing to be in form for allowance, early notification of same is respectfully requested. The Examiner is invited to contact the undersigned by telephone if doing so would be of assistance.

Respectfully submitted,

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